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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/686,991

10/15/2003

Robert Cantwell

23937-43

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38077

7590

06/18/2007

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EXAMINER

GROSSO, HARRY A

ART UNIT

PAPER NUMBER

3781

MAIL DATE

DELIVERY MODE

06/18/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/686,991

Applicant(s)

CANTWELL ET AL.

Examiner

Harry A. Grosso

Art Unit

3781

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,5,7-9,11-13 and 15-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5,7-9,11-13 and 17-21 is/are rejected.
- 7) ☒ Claim(s) 15 and 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 March 2007 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 20, 2007 has been entered.

### ***Drawings***

The drawing objection in the previous Office Action under 37 CFR 1.83(a) has been overcome by the amendment filed April 19, 2007. The objection is withdrawn.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the beverage holder configured to lock in the expanded configuration (claims 13 and 17) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate

changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 5, 8, 9, 11-14, and 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holub et al in view of Dennis et al (6,834,838).
3. Regarding claims 1, 9, 18 and 21, Holub et al discloses an insulated container (Figures 1A-1B, column 2, lines 53-65, column 3, lines 22-30). The top panel (110) has a beverage holder (116, Figure 10A, column 6, lines 17-34). The bottom of the cup holder is of the same material as the lid and, thus, prevents heat transfer. Holub et al does not teach an expandable beverage holder. Dennis et al discloses a beverage holder mounted in a flat panel (Figure 2) with an expandable portion using a telescoping construction (column 4, lines 11-16) that can be raised to provide better securement for a tall beverage container or allow secure placement of a beverage container with a

handle (Figures 1-7). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the expandable feature of the beverage holder disclosed by Dennis et al in the top panel of the container of Holub et al to provide better securement for a tall beverage container or allow secure placement of a beverage container with a handle. The beverage holder of Holub et al as modified by Dennis et al extends away from the storage space when expanded.

4. Regarding claims 5 and 19, the beverage holder of Holub et al as modified by Dennis et al is configured to allow heat transfer in that the extendable portion is not specified as an insulating material and would allow some amount of heat transfer.

5. Regarding claim 8, Holub et al discloses the body is coupled to the cover by hinges (115, column 2, lines 57-58).

6. Regarding claims 11 and 20, the beverage holder of Holub et al as modified by Dennis et al is expanded away from the storage space and collapsed using a telescoping construction (column 4, lines 11-16).

7. Regarding claim 12, the side of the beverage holder of Holub et al as modified by Dennis et al is configured to compress when moved to the collapsed configuration.

8. Regarding claims 13 and 17, the beverage holder of Holub et al as modified by Dennis et al is configured to lock in the expanded configuration (Figures 6 and 7).

9. Claims 1, 5, 7-9, 11-13, and 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mogil et al (2005/0072181 A1) in view of Dennis et al (6,834,838).

10. Regarding claims 1, 9, 18 and 21, Mogil et al discloses an insulated container (Figures 1A-1B, 6A, paragraphs 0095 and 0162). The top panel (334) has a beverage

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holder (342, Figure 6A, paragraph 0162). The bottom of the cup holder is of the same material as the lid and, thus, prevents heat transfer. Mogil et al does not teach an expandable beverage holder. Dennis et al discloses a beverage holder mounted in a flat panel (Figure 2) with an expandable portion that can be raised using a telescoping construction (column 4, lines 11-16) to provide better securement for a tall beverage container or allow secure placement of a beverage container with a handle (Figures 1-7). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the expandable feature of the beverage holder disclosed by Dennis et al in the top panel of the container of Holub et al to provide better securement for a tall beverage container or allow secure placement of a beverage container with a handle. The beverage holder of Mogil et al as modified by Dennis et al extends away from the storage space when expanded.

11. Regarding claims 5 and 19, the beverage holder of Mogil et al as modified by Dennis et al is configured to allow heat transfer in that the extendable portion is not specified as an insulating material and would allow some amount of heat transfer.

12. Regarding claim 7, Mogil et al discloses the body of the container is soft-sided and the outer edge of the top would have to be of the same soft-sided construction for the fabric hinge on the back edge of the top and to accommodate the zipper shown in Figure 6A.

13. Regarding claim 8, Mogil et al discloses the body is coupled to the cover by a fabric hinge (paragraph 0105).

14. Regarding claims 11 and 20, the beverage holder of Mogil et al as modified by Dennis et al is expanded away from the storage space and collapsed using a telescoping construction (column 4, lines 11-16).

15. Regarding claim 12, the side of the beverage holder of Mogil et al as modified by Dennis et al is configured to compress when moved to the collapsed configuration.

16. Regarding claims 13 and 17, the beverage holder of Mogil et al as modified by Dennis et al is configured to lock in the expanded configuration (Figures 6 and 7).

***Allowable Subject Matter***

17. Claims 15 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

18. Applicant's arguments filed March 19, 2007 have been fully considered but they are not persuasive. Applicant argues that both Holub et al and Mogil et al as modified by Dennis et al do not disclose an "expandable beverage holder having a telescoping construction and movable between a collapsed configuration and an expanded configuration, in the expanded configuration the expandable beverage holder one of extending outwardly with respect to the storage space and extending inwardly with respect to the storage space." In response, the claim language of the independent claims of the instant application is read by the Examiner to recite an expandable beverage holder expanding either outwardly with respect to the storage space or inwardly with respect to the storage space. The expandable beverage holder of Holub et

al or Mogil et al as modified by Dennis et al would have a beverage holder that extends outwardly with respect to the storage space, thus meeting the limitation of the claims.

19. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both Holub et al and Dennis et al are dealing with container holders and Dennis et al teaches the desirability to have a beverage holder expand upward using a telescoping construction to provide better securement for a tall beverage container. Knowledge of this type of beverage holder would be available to one of ordinary skill in the art.

20. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).



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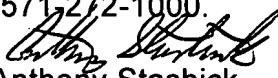
21. The applicant provides the same arguments as above for the combination of Mogil as modified by Dennis et al. The same responses presented above would apply.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harry A. Grosso whose telephone number is 571-272-4539. The examiner can normally be reached on Monday through Thursday from 7am to 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Stashick can be reached on 571-272-4561. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Anthony Stashick  
Supervisory Patent Examiner  
Art Unit 3781

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